UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,060	01/08/2001	Jill E. Wood	BAYER-1 D1	8038

23599 7590 05/13/2004

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER	
POWERS, FIONA	

ART UNIT	PAPER NUMBER
1626	

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 20040506

Application Number: 09/755,060
Filing Date: January 08, 2001
Appellant(s): WOOD ET AL.

Harry B. Shubin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 5, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 18 to 31 stand or fall together because appellant's brief does not include a statement that this

grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18 to 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 1 to 18 of U.S. Patent No. 6,187,799. Although the conflicting claims are not identical, they are not patentably distinct from each other because a substantial amount of the compounds in the claims are identical. For example, the twenty nine compounds used in the method of instant claim 18 are the same as twenty nine of the thirty compounds used in the method of claim 1 of the patent. One of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that they would be useful for the same purpose as disclosed in the patent.

(11) Response to Argument

Appellants argue that there is no motivation for one of ordinary skill in the art to delete, from the claims of the parent, the 30^{th} compound. One of ordinary skill in the art would have been motivated to delete the 30^{th} compound to obtain 29 compounds that are useful for the same purpose as are the 30 compounds of the patent, which is the treatment of cancerous cell growth mediated by raf kinase.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Fiona T. Powers

Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
May 12, 2004

Conferees

Joseph K. McKane

JOSEPH K. McKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

Johann Richter

JOHANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1600